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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,630	08/13/2001	Andreas Natsch	A 13470 US (C36368/125381)	8014

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EXAMINER

BADIO, BARBARA P

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/928,630

Applicant(s)

NATSCH, ANDREAS

Examiner

Barbara P. Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**First Office Action on the Merits**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on August 14, 2000. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Darsow ('648).

Darsow teaches isocamphylcyclohexanols such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane and their use in soaps, cosmetic products and perfume (see the entire article, especially col. 1, lines 10-44; examples 1-3). The composition taught by the reference is encompassed by the instant claims.

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4. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. ('203).

Hall teaches perfume compositions and colognes containing a mixture of odoriferous compounds (see the entire article, especially col. 4, lines 7-59; col. 8, line 51 – col. 9, line 67; examples IV-VII). The reference teaches compounds such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see especially col. 4, lines 45-59). The composition taught by the reference is encompassed by the instant claims.

***Claim Rejections - 35 USC § 103***

- m  
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darsow ('648), Hall et al. ('203) and Robinson et al. ('602) in combination.

Darsow teaches isocamphylcyclohexanols such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane and their use in soaps, cosmetic products and perfume (see the entire article, especially col. 1, lines 10-44; examples 1-3).

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Hall teaches perfume compositions and colognes containing a mixture of odoriferous compounds (see the entire article, especially col. 4, lines 7-59; col. 8, line 51 – col. 9, line 67; examples IV-VII). The reference teaches compounds such as 2-hydroxy-1-(5-isocamphyl)cyclohexane, 3-hydroxy-1-(5-isocamphyl)cyclohexane and 4-hydroxy-1-(5-isocamphyl)cyclohexane (see especially col. 4, lines 45-59).

The instant claims differ from the above-cited references by reciting additional compounds not exemplified by the references. For example, claims 2 and 4 differ from the reference by reciting 2-methoxy derivatives of the exemplified prior art compounds.

Claims 5, 6 and 8-10 differ from the reference by reciting incorporation of specific amounts of the compound into perfume.

Claims 7, 10 and 17 differ from the reference by reciting the addition of farnesol.

Claim 11 differ from the reference by reciting additional ingredients.

Claims 12-18 differ from the reference by reciting specific products and method of making a personal care product.

However, (a) the genus taught by the Darsow includes said 2-methoxy derivatives (see col. 1, lines 25-44, i.e., compounds wherein  $X = OCH_3$ ); (b) preparation of products as taught by the references using various amounts of the compounds is within the level of skill of the ordinary artisan; (c) farnesol is a known bacteriostatic agent used in cosmetic products (see Robinson et al., col. 1, lines 53-58) and (d) the references teach the use of the compounds in personal care products such as soaps, cosmetic products and perfume. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the species of the

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genus taught by the reference, including that of the instant claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole. It is also within the level of skill of the ordinary artisan in the art at the time of the invention to utilize various amounts of the compounds in different cosmetic products etc. as well as to incorporate various ingredients known to be useful in the cosmetic art in the preparation of said products. Based on the level of skill of the ordinary artisan in the art at the time of the invention and the teachings of the prior art, the claimed invention is prima facie obvious.

### ***Telephone Inquiry***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB

March 5, 2003